

REMARKS

In the Action, claims 1-10 and 12-14 are rejected. In response, claims 1 and 8 are amended, and claim 2 is cancelled. The pending claims are claims 1, 3-10 and 12-14. In view of these amendments and the following comments, reconsideration is requested.

Rejection of Claims 1 and 2 Under 35 U.S.C. § 103(a)

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,486,267 to Prusas (hereinafter "Prusas").

Prusas discloses impregnation of wood chips with an alkaline chemical liquor containing a chelating agent in the production of chemithermomechanical pulp only when hydrogen peroxide is used in the alkaline chemical liquor (column 5, lines 45-48) to prevent decomposition of the peroxide by metal ions, such as iron and manganese ions in the wood.

By the present Amendment, claim 2, whose recitation includes use of an alkaline inorganic compound and a chelating agent, has been cancelled and replaced by amended claim 1 which recites that the wood chips are impregnated with a "chemical liquor consisting essentially of an alkaline inorganic compound and a chelating agent..." (Emphasis added). The language "consisting essentially of" has been held to distinguish prior art where the presence of a component, such as the peroxide of Prusas, would materially affect the basic and novel characteristics of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).

As shown in the newly-submitted Kamijo declaration, the addition of hydrogen peroxide resulted in a lower brightness as compared with use of such solution including a chelating agent absent the hydrogen peroxide. Thus, the brightness of the pulp after bleaching using the chemical agent in Reference Example 1 (page 2, last paragraphs of the Kamijo declaration) was lower than that achieved in Examples 9-13 in which chips are

impregnated with a chemical agent containing a chelating agent without hydrogen peroxide. Examples 9-13 in Table 1 of the declaration correspond to those same examples in Table 1 on page 18 of the present application. As indicated in the declaration, "the pulp produced from chips impregnated with a chemical agent containing a chelating agent and hydrogen peroxide, as in U.S. Patent No. 4,486,267 [the Prusas patent] is more difficult to bleach than that produced from chips impregnated with a chemical agent containing a chelating agent only."

As demonstrated by the Kamijo declaration, the hydrogen peroxide of Prusas materially affects the basic and novel characteristics of the claimed process. Accordingly, claim 1, as amended, distinguishes Prusas and the rejection of claim 1 should be withdrawn.

Rejection of Claims 3 and 4 Under 35 U.S.C. § 103(a)

Claims 3 and 4 are rejected as being unpatentable over Prusas in view of U.S. Patent Publication No. 2001/0050151 A1 to Sabourin. Sabourin is relied on as showing the compression ratio recited in claims 3 and 4.

Claims 3 and 4 are dependent from amended claim 1, so that claims 3 and 4 are similarly distinguishable from Prusas for the reasons discussed above. Since Sabourin is not relied on for this purpose, as indicated in paragraph 4 of the Continuation Sheet of the Office Action mailed August 1, 2006, Sabourin does not cure the deficiencies of Prusas. Accordingly, the rejection of claims 3 and 4 should be withdrawn.

Rejection of Claims 5 and 6 Under 35 U.S.C. § 103(a)

Claims 5 and 6 are rejected as being unpatentable over Prusas as applied to claims 1 and 2, in view of Pete. Claims 5 and 6 are dependent from amended claim 1, so that claims 5

and 6 are similarly distinguishable from Prusas for the reasons discussed above. Since Pete does not cure the deficiencies of Prusas, the rejection of claims 5 and 6 should be withdrawn.

Rejection of Claim 7 Under 35 U.S.C. § 103(a)

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Prusas and Sabourin, and further in view of Pete. Claim 7 is ultimately dependent from amended claim 1, so that it is similarly distinguishable from Prusas for the reasons discussed above. Since neither Sabourin nor Pete cure the deficiencies of Prusas, the rejection of claim 7 should be withdrawn.

Rejection of Claims 8-10 and 12-14 Under 35 U.S.C. § 103 (a)

Claims 8-10 and 12-14 are rejected over U.S. Patent No. 2,687,943 to Pete (hereinafter "Pete") in view of Prusas.

By the present Amendment, claim 8 has been amended to add the recitation "in order" prior to the recited steps, thereby requiring the recited steps to be practiced in the order recited. Accordingly, claim 8 recites that the primary refining step (a) for defibrating wood chips having low bleachability, and the secondary refining in which bleached pulp is further beaten in step (d) are separated by the washing and dehydration step b) and the bleaching step c).

Pete does not disclose the process recited in amended claim 8, and Prusas does not cure the deficiencies, since Prusas does not disclose nor suggest practicing the process in the order recited.

In contradistinction thereto, in Applicant's claimed process of claim 8, wood chips having low bleachability are, in order, defibrated in step a) of claim 8 by primary refining; the resulting pulp fibers are washed in step and dehydrated in (b); bleached in step (c) and further

beaten by secondary refining in step (d). Pete fails to disclose the claimed primary refining step (a) and the secondary refining step (d) separated by a washing/dehydration step and a bleaching step as recited.

In fact, Pete discloses no secondary refining step whatsoever. Additionally, Pete discloses grinding wood, not "defibration". Thus, Pete, in column 1, lines 1-3, describes grinding wood; in Example 1 he uses ground hemlock; grinding is disclosed in lines 1-2 of Example 2; and ground wood pulp mentioned in line 1 of Example 3. Thus, Pete is grinding wood, not defibrating wood chips by primary refining. Wood materials are ground to form wood chips, which is different from defibration by primary refining.

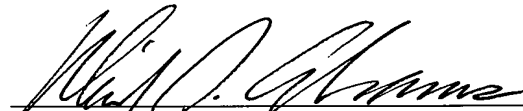
Prusas cannot remedy the deficiencies of Pete, since Prusas fails to disclose washing and bleaching between primary and secondary refining, as required by amended claim 8. Where a reference does not disclose a feature of a claim relied on to distinguish the prior art, it cannot suggest modifying the prior art to contain that feature. *In re Civitello*, 144 USPQ 10 (1964 CCPA).

Accordingly, the rejection of claim 8 over Pete in view of Prusas should be withdrawn.

Claims 9, 10 and 12-14 are all dependent from claim 8 and distinguish the combination of Pete in view of Prusas for the reasons previously given in regard to claim 8.

In view of the amendments and the above comments, reconsideration and allowance are requested.

Respectfully submitted,



David S. Abrams
Reg. No. 22,576

Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, N.W., Suite 600
Washington, DC 20036
(202)659-9076

Dated: February 6, 2007